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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/430,177 10/29/99 NARANG

U 100448.01

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HM12/1009

EXAMINER

WARE, T

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/430,177

Applicant(s)

NARANG ET AL.

Examiner

Todd D Ware

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-144 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-144 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### **DETAILED ACTION**

Receipt of Ids filed 6-5-01 and request for extension of time, amendment and terminal disclaimer all filed 7-24-01 is acknowledged. Claim 53 has been canceled and claims 6, 26, 40, 52, 54, 76 and 82 have been amended as requested. Based upon the new grounds for rejection, this action is "non-final."

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (WO 97/31598; hereafter '598) or Leung (WO 96/40797; hereafter '797).

'598 and '797 teach substantially the same methods of making applicator tips and applicators as the instant claims. The applicators and applicator tips of '598 and '797 comprise antibacterial agents and the applicators have a conduit for an adhesive composition where the composition may flow through the applicator to the applicator tip. The tips are porous and may be made of foam in a variety of shapes. Neither '598 nor '797 teaches the specific antimicrobial agents of the instant claims, however it is submitted that these agents are known antimicrobial agents and based upon the inclusion of antimicrobial agents in '598 and '797 it would have been obvious to one skilled in the art at the time of the invention to include the specific antimicrobial agents, absent a demonstration of criticality thereto.

'598 and '797 also do not teach forming a concentration gradient of the agent, however it would have been obvious to one skilled in the art at the time of the invention to utilize a concentration gradient to allow the agent to flow from the conduit to the applicator tip.

'598 and '797 also do not teach kits comprising sealable packages comprising the applicators and applicator tips, however they do teach separate storage within an applicator container. Sealability of these would have been obvious to one skilled in the art at the time of the invention to permit re-use of the applicators while minimizing exposure to environment, subsequent exposure to micro-organisms and degradation of the active agent.

'598 and '797 do not teach methanol as the solvent, however they do teach ethanol as the solvent, which differs as an adjacent homolog. Therefore, the claimed invention would have been obvious to the skilled artisan because close structural similarity of the reference compound suggests the claimed compound. One skilled in the art would expect the two compounds to have similar properties.

'598 and '797 also meet the requirement where the applicator tip is made of reticulated material. Merriam Webster's Collegiate Dictionary defines reticulated as "constructed so as to form a network." '598 and '797 disclose that the applicator tip is composed of a honey-comb material or a material having a woven pattern.

'598 and '797 also meet the requirement where the applicator body is free of a polymerizable adhesive reservoir as they disclose that the applicator body is a swab.

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Furthermore, these references also meet the requirement where the method of making utilizes a vacuum as they disclose heating the applicator tip in a vacuum oven.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-144 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on 7:30 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

THURMAN K PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

tw  
October 4, 2001